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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/438,955	11/12/1999	RICKARD MARKS VON WURTEMBERG	21513	1076

7590 07/05/2002

LAWRENCE E LAUBSCHER JR
LAUBSCHER & LAUBSCHER
SUITE 300
745 SOUTH 23RD STREET
ARLINGTON, VA 22202

EXAMINER

JACKSON, CORNELIUS H

ART UNIT

PAPER NUMBER

2828

DATE MAILED: 07/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/438,955	VON WURTEMBERG ET AL.
	Examiner	Art Unit
	Cornelius H. Jackson	2828

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 April 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.



PAUL J.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04 April 2002 has been entered.

Acknowledgment

2. Acknowledgment is made that applicant's Amendment, filed on 04 April 2002, has been entered. Upon entrance of the Amendment, claims 1 and 11 were amended. Claims 1-17 are now pending in this application.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1-3 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the position/placement of the "substrate" and/or "photon-transparent ohmic contact" with respect to the other stated elements. These structural relationships, which are found in claims 2 and 3, should be added to claim 1. Claims 4-17 are rejected on the basis of depending on indefinite claim 1.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 1-7, 9-13 and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Lin et al. (5838708). Lin et al. discloses a surface emitting laser with a monitor (**Title**) consisting essentially of a plurality of spaced apart mirrors **202 and 206**, a light amplifying region between the mirrors **204**, a substrate **212**, and a photon transparent ohmic contact for passing light energy therethrough whereby light emission through said surface emitting laser may be monitored, **see column 3, line 64 through column 4, line 53**.

In regard to claims 2-3, 5 and 9-10, Lin et al. teaches all stated limitations, **see column 3, line 64 through column 4, line 53.**

In regards to claim 4, Lin et al. teaches all stated limitations, **see column 1, lines 25-55 and Fig. 1.**

In regards to claim 6, Lin et al. teaches all stated limitations, **see column 5, lines 5-10.**

In regards to claim 7, Lin et al. teaches all stated limitations, **see column 4, lines 64-65.**

In regard to claims 11-13 and 15-17, the method of forming a device is not germane to the issue of patentability of the device itself, since the device is obtained by the method of forming.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al. Lin et al., as applied above, discloses the claimed invention except for the ohmic contact comprising indium tin oxide. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used indium tin oxide if so desired to suite production costs or whatever the case maybe, since it has been

held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

In regards to claim 8, the method of forming a device is not germane to the issue of patentability of the device itself, since the device is obtained by the method of forming.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kim (EPO 803943 A2) teach a surface emitting laser with a monitor (**Title**) consisting essentially of a plurality of spaced apart mirrors **121 and 123**, a light amplifying region between the mirrors **13**, a substrate **14**, and a photon transparent ohmic contact **11** for passing light energy therethrough whereby light emission through said surface emitting laser may be monitored.

Kish, Jr. et al. (US 5724376 A) teach a surface emitting laser with a monitor **Figs.4 and 6A-B** consisting essentially of a plurality of spaced apart mirrors **53 and 55**, a light amplifying region between the mirrors **51**, a substrate **212**, and a photon transparent ohmic contact (**contact metallization/photodetector**) for passing light energy therethrough whereby light emission through said surface emitting laser may be monitored.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cornelius H. Jackson whose telephone number is (703) 306-5981. The examiner can normally be reached on 8:00 - 5:00, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Ip can be reached on (703) 308-3098. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7722 for regular communications and (703)308-7721 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.



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chj
July 1, 2002